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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,428	07/16/2003	Takasuke Nakanishi	KAN-001 (10029)	6930

62479 7590 01/04/2007  
HAHN & VOIGHT PLLC  
1012 14TH STREET, NW  
SUITE 620  
WASHINGTON, DC 20005

EXAMINER
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ANDERSEN, MICHAEL T

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/619,428

Applicant(s)

NAKANISHI, TAKASUKE

Examiner

M. Thomas Andersen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/16/2004, 11/16/2005, 5/23/2006.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements (IDS) received on 1/16/2004, 11/16/2005 and 5/23/2006 are acknowledged. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Fucci, U.S. 5,286,253.

Claim 1: Fucci discloses a surgical instrument comprising a cutting tool having an elongate flexible shank 10 and a burr 34 provided at the distal end; a tubular sheath 20 for receiving the cutting tool; an interposed member (col. 2, lines 38-40) interposed between the elongate tube portion of the sheath and the shank of the cutting tool; a handpiece body 30 connected to the sheath, and detachably holding the proximal end of the cutting tool for transmitting driving force from a drive source to the cutting tool; wherein the elongate tube portion of the sheath is malleable and deformable (col. 3, line 42), and a shank of the cutting tool and the interposed member are deformable following malleable deformation of the elongate tube portion.

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Claim 2: The interposed member is tubular and flexible. Figure 1.

Claim 3: The interposed member is made of a fluororesin, and acts as a sliding bearing for the shank of the cutting tool. Col. 4, lines 61-65.

Claim 5: Fucci discloses a burr 34 at the distal end of the cutting tool for cutting a treatment site; an elongate flexible shank 10; a bearing contact portion (near numeral 36) positioned between the bur and the shank, and to be supported by a bearing in a medical handpiece when the cutting tool is mounted in the medical handpiece 30; wherein the shank has a first section to be chucked in a handpiece body of the medical handpiece (see numerals 30, 56), and a second section having sufficient flexibility to be elastically deformed more easily than the first section. Cf. numerals 20 and 22.

Claim 6: The second section has a diameter smaller than the diameter of the first section. Cf. numerals 14 and 22.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fucci as applied to claim 1 above in view of Brown, U.S. 6,514,258.

Fucci does not expressly disclose that his cutting tool has a marker that matches a marker of the same color of the sheath. However, Brown discloses that it is well-known in the art to use markings on surgical tools to help the clinician know which bits

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to connect and the corresponding length of the cutting tool. It would have been obvious to one having ordinary skill in the art at the time of the invention to use matching color markings, as disclosed by Brown, on the surgical device disclosed by Fucci, in order to help the clinician connect the correct cutting tool with the correct sheath or handpiece.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bonutti, 6,468,289, disclosing a cutting tool; Del Rio, U.S. 5,494,359, disclosing a tool shaft bearing system; Binkley, U.S. 1,630,239, disclosing an antrum burr.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Thomas Andersen whose telephone number is (571) 272-8024. The examiner can normally be reached on M-F 8AM-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Thomas Andersen

December 18, 2006

A handwritten signature in black ink, appearing to read "MJ Hayes", with a stylized flourish at the end.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER